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FROM • Michael L. Day

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MESSAGE •

AMENDED PETITION UNDER 37 CFR §1.55(c) follows for Application No. 09/932,013,
Filed August 17, 2001

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: David Barrington Everett et al.

Application No.: 09/932,013

Filed: August 17, 2001

Title: SECURE MULTIPLE APPLICATION
CARD SYSTEM AND PROCESS

Group Art Unit: 2137

Examiner: Mathew Smithers

Attorney Docket No.: 40000059-0150

Confirmation No.: 4815

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Date of Deposit

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AMENDED PETITION UNDER 37 C.F.R. §1.55(c) AND PETITION UNDER 37 C.F.R.
§1.78(a)(3)

Sir:

On March 2, 2007, Applicants mailed and faxed to the United States Patent and Trademark Office (USPTO) a Renewed Petition under 37 C.F.R. §1.55(c) for acceptance of an unintentionally delayed claim of priority (the "Renewed Petition"), responsive to the Decision on Petition under 37 C.F.R. §1.55 mailed by the USPTO on January 30, 2007. In light of the USPTO's Decision on Petitions under 37 C.F.R. §§1.55 and 1.78 mailed June 29, 2007 (the "June 29 Decision"), and a telephone conference between Applicants' attorneys (Edward Radlo and Michael Day) and Legal Examiner Lin held July 12, 2007, the present Amended Petition under 37 C.F.R. §1.55(c) and Petition Under 37 C.F.R. §1.78(a)(3) are submitted herewith. The following are submitted:

Amended Petition under 37 C.F.R. §1.55(c) begins on page 3 of this paper.

Petition under 37 C.F.R. §1.78(a)(3) begins on page 4 of this paper.

Remarks begin on page 5 of this paper.

Enclosures (via USPS only):

- (1) Cover page of Pub. No. US 2001/0056536A1 (27 Dec. 01)
- (2) USPTO "Bib Data Sheet" for the instant application

- (3) Printout of Parent Continuity Data from Public PAIR
- (4) Cover page of U.S. patent 6,317,832 B1 (the Parent), issued 13 Nov. 01, with Certificates of Correction
- (5) 66 FR 67087
- (6) MPEP 8th Edition, First Revision, February 2003, pp. 200-67 through 200-70
- (7) MPEP, 8th Edition, August 2001, pp. 200-66 through 200-69
- (8) Official Gazette Notice published 18 March 2003:
<http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>
- (9) <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>

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AMENDED PETITION UNDER 37 C.F.R. §1.55(c)

Pursuant to 35 U.S.C. §119(a) and 35 U.S.C. §120, the instant application is entitled to the benefit of the filing date of the following prior application: Great Britain patent application No. 9703591.9 filed on February 21, 1997 and entitled "Multiple Application Computer System." Applicants unintentionally failed to expressly claim this priority in the instant application as filed, and unintentionally failed to present this claim during the time period provided by 37 C.F.R. §1.55(a).

**APPLICANTS HEREBY PETITION FOR ACCEPTANCE OF THE
UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

(1) CLAIM: This application is a continuation of and claims priority to United States patent application no. 09/076,551, filed on May 12, 1998, entitled "Secure Multiple Application Card System and Process," now U.S. patent 6,317,832, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled "Design for a Multi Application Smart Card" and United States provisional patent application 60/046,543 filed on May 15, 1997, entitled "Virtual Machine for a Multi Application Smart Card"; United States patent application no. 09/076,551 is a continuation of and claims priority to United States patent application 09/023,057 filed on February 12, 1998, entitled "Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability," now U.S. patent 6,575,372, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled "Design for a Multi Application Smart Card" and Great Britain patent application 9703591.9 filed on February 21, 1997, entitled "Multiple Application Computer System.

(2) PETITION FEE: The surcharge of one thousand three hundred seventy dollars (\$1,370.00) set forth in 37 C.F.R. §1.17(t) for a large entity was included with the original Petition to Accept Unintentionally Delayed Claim of Priority, mailed November 20, 2006.

(3) STATEMENT: The entire delay between the date the claim was due under 37 C.F.R. §1.55(a)(1) and the date the claim was filed was unintentional.

PETITION UNDER 37 C.F.R. §1.78(a)(3)

Pursuant to 35 U.S.C. §120, the instant application is entitled to the benefit of the filing date of the following prior application: United States patent application 09/023,057 filed on February 12, 1998, entitled "Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability," now U.S. patent 6,575,372 (the "Grandparent"). Applicants expressly claimed priority to said Grandparent in the first sentence following the title of the instant application as originally filed, as required by 37 C.F.R. §1.78 (a)(2)(iii), and accurately identified the instant application as "a continuation of" the intermediate prior application 09/076,551 (the "Parent"), but did not expressly state in the instant application that the Parent is "a continuation of" the Grandparent.

**APPLICANTS HEREBY PETITION FOR ACCEPTANCE OF THE
UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

(1) CLAIM: This application is a continuation of and claims priority to United States patent application no. 09/076,551, filed on May 12, 1998, entitled "Secure Multiple Application Card System and Process," now U.S. patent 6,317,832, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled "Design for a Multi Application Smart Card" and United States provisional patent application 60/046,543 filed on May 15, 1997, entitled "Virtual Machine for a Multi Application Smart Card"; United States patent application no. 09/076,551 is a continuation of and claims priority to United States patent application 09/023,057 filed on February 12, 1998, entitled "Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability," now U.S. patent 6,575,372, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled "Design for a Multi Application Smart Card" and Great Britain patent application 9703591.9 filed on February 21, 1997, entitled "Multiple Application Computer System.

(2) PETITION FEE: The surcharge of one thousand three hundred seventy dollars (\$1,370.00) set forth in 37 C.F.R. §1.17(t) for a large entity was included with the original Petition to Accept Unintentionally Delayed Claim of Priority, filed November 20, 2006.

(3) STATEMENT: The entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2) and the date the claim was filed was unintentional.

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REMARKS

Favorable consideration of this Amended Petition under 37 C.F.R. §1.55(c) and Petition under 37 C.F.R. §1.78(a)(3) (the "Instant Petitions") is hereby respectfully requested.

In the June 29 Decision, the USPTO dismissed the Renewed Petition under 37 C.F.R. §1.55(c) filed on March 2, 2007, concluding that (1) "the instant application does not contain a proper benefit claim under 35 U.S.C. 120 and 37 C.F.R. 1.78(a)(2) to U.S. application number 09/023,057" (the Grandparent), and (2) the Renewed Petition, when treated as a petition under 37 C.F.R. §1.78 to accept an unintentionally delayed claim under 35 U.S.C. §120 to U.S. application 09/023,057 (the Grandparent), was defective.

Reconsideration of the June 29 Decision, and acceptance of the priority claims to the Grandparent and to Great Britain application 9703591.9 are appropriate, for at least the following reasons: (1) the instant application, as amended for publication, included a proper priority benefit claim under 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2) to the Grandparent; (2) the June 29 Decision improperly retroactively applied MPEP provisions published after the instant application was filed; and (3) the June 29 Decision is contrary to the USPTO practice announced December 28, 2001 at 66 FR 67087, 67091 (Enclosure 5). The foregoing three reasons are each elaborated below under the corresponding numbered paragraphs.

1. Any failure of the Applicants to comply with 37 C.F.R. §1.78(a)(2) in the application-as-filed was cured by publication of the application on December 27, 2001 (the "Amended Application"). As amended for publication by the USPTO, the priority claim in the Amended Application, item (63) on the cover sheet of Pub. No. US 2001/0056536 (enclosure 1), states "Continuation of application No. 09/076,551, filed on May 12, 1998, now Pat. No. 6,317,832, which is a non-provisional of provisional application No. 60/046,514, filed on May 15, 1997 and which is a non-provisional of provisional application No. 60/046,543, filed on May 15, 1997 and which is a continuation of application No. 09/023,057, filed on Feb. 12, 1998." This priority claim expressly states that the Parent is "a continuation of" the Grandparent. As provided by 37 C.F.R. §1.78 (a)(2)(iii), "the specification must contain or be amended to contain such

reference in the first sentence(s) following the title.” [emphasis added]. Similar language is provided in 37 C.F.R. §1.78 (a)(2)(i). Nothing in 37 C.F.R. §1.78(a)(2)(i) or (iii) requires that the specification be amended by Applicants. Here, the application-as-filed was amended by the USPTO, as permitted by 37 C.F.R. §1.78 (a)(2)(i) and (iii), and the published amended application satisfies the requirements of 37 C.F.R. §1.78(a)(2)(i) and (iii).

2. The June 29 Decision is improperly grounded on language from an August 2006 version of MPEP 201.11(II)(A) that post-dates the filing of the instant application. The MPEP language cited by the USPTO (“if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications”) was first introduced to the MPEP in February 2003, eighteen months after the instant application was filed, and identifies new requirements not stated in the MPEP version(s) extant as of the 2001 filing date. [compare pages 200-67 through 200-70 of Feb 2003 MPEP (Enclosure 6) with pages 200-66 through 200-69 of Aug. 2001 MPEP (Enclosure 7)]. The background and rationale for this change, implemented by the USPTO in February 2003, may be found in the Official Gazette Notice published 18 March 2003 [Enclosure 8, <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>]

Nothing in the MPEP or the related Official Gazette Notice suggests that this policy change was intended to be applied retroactively. Doing so in the case of the instant application is both unfair and unnecessary, since, as stated above, the instant application was amended within five months of its filing date by the USPTO to expressly state that the Parent is “a continuation of” the Grandparent.

As of the filing date of the instant application, both the MPEP and 37 C.F.R. §1.78 required identifying only the “relationship” of the applications in the priority chain, without defining “relationship.” The word “relationship” could be construed to mean “A claims priority upon B” as easily as “A is a continuation of B”. It is evident from Enclosure 8 that many applicants and practitioners so construed “relationship” [see section entitled “Statement of the Problem”. Remarkably, although the MPEP revision of February 2003 clarifies the USPTO’s definition of “relationship”, 37 C.F.R. §1.78 to this

very day still fails to incorporate such definition, notwithstanding that 37 C.F.R. §1.78 has been amended six times since the instant application was filed.

3. Although the first sentence of the instant application's specification-as-filed did not expressly state that the Parent is "a continuation of" the Grandparent, the fact of the continuation relationship between Parent and Grandparent has been amply recognized by the USPTO and identified to the public since at least November 13, 2001, by way of at least the following:

- (1) the application as published on December 27, 2001 (cover, item (63))
(Enclosure 1)
- (2) the USPTO's Bibliographic Data Sheet (Enclosure 2)
- (3) Public PAIR's continuity database (Enclosure 3)
- (4) The face of the issued Parent, U.S. patent no. 6,317,832 (issued November 13, 2001) (Enclosure 4)

Given that the above-listed publicly available references expressly stated that the Parent is "a continuation of" the Grandparent, Applicants had no reason to believe that the priority benefit claim to the Grandparent application under 35 U.S.C. §120 required any correction, particularly in light of the following announced Office practice:

"The Office has adopted the following practice: if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. 66 FR 67087, 67091 [Enclosure 5 (emphasis added)].

Applicants have been unable to locate a copy of the instant application's filing receipt, which should have been mailed to the Manhattan, New York, NY, mailing address of Applicants' former attorney of record. During a telephone conference

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conducted on July 16, 2007 between Michael Day of Sonnenschein Nath & Rosenthal LLP, and Valarie Kinard, a supervisor in the Office of Initial Patent Examination at the USPTO, Ms. Kinard indicated that, according to the USPTO's records, the filing receipt was mailed on September 14, 2001. Ms. Kinard further indicated that the USPTO itself did not retain either a physical copy or a scanned image of the originally mailed filing receipt. Applicants surmise that the 2001 filing receipt was lost as a result of the postal service interruptions associated with the tragic events of September 11, 2001 (see, e.g., <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>, Enclosure 9).

The four above-listed references published by the USPTO at about the same time as the originally-mailed filing receipt provide uncontroverted evidence that this originally-mailed filing receipt included the same domestic priority data as those four references, thereby satisfying the requirements of the above-cited USPTO practice, as memorialized in the Federal Register.

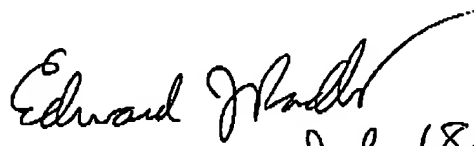
Thus, in accordance with the announced USPTO practice, Applicants' correction of the specification to conform with the filing receipt may be accomplished informally, without the need for a petition for a delayed priority claim.

Conclusion

Whether or not an amendment can be entered into the application at this time under 37 C.F.R. §1.312, Applicants earnestly request that the June 29 Decision be reconsidered and the Instant Petitions be granted. Thereby, Applicants will be afforded a clear statement from the USPTO that Applicants have secured the priority claims to which they are entitled. Applicants will then determine with the responsible USPTO Examiner how to best implement the new decision in the instant application. Therefore, Applicants respectfully request the USPTO to (1) suspend issuance of the instant application until the USPTO disposes of the Instant Petitions; (2) grant the Instant Petitions; and, (3) return the instant application for further prosecution in accordance with the granted Instant Petitions.

If there are any additional fees due in connection with this communication,
please charge Deposit Account No. 19-3140. This sheet is being submitted in duplicate.

Respectfully submitted,


Edward J. Radlo
Attorney of Record
Reg. No. 26,793
July 18, 2007

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- (9) <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>

cc: B. McKeon (w/ encl.)
IP/T docket CH (w/o encl.)